

REMARKS

Claims 15-17 and 19-33 are pending. Claims 1-14, previously withdrawn from consideration, are canceled without prejudice or disclaimer in order to advance prosecution. Applicant hereby expressly reserves the right to pursue one or more of claims 1-14 in one or more divisional and/or continuation applications hereof.

Claim 33 is added. Support for the new claim can be found, *inter alia*, at paragraph [00149] of the specification and in Figure 19. No new matter is introduced.

Applicant has thoroughly reviewed the Office action, including the Examiner's remarks and the references cited therein. Applicant submits that the following remarks are fully responsive to the Office action, and that all pending claims are patentable over the cited references.

Summary of the November 21, 2007 Interview

Applicant thanks the Examiner for the courtesy of a telephonic interview on November 21, 2007 ("the Interview"). Pursuant to MPEP § 713.04, Applicant provides the following summary of the substance of the Interview.¹

Claim 15 and United States patent no. 6,216,045 to Black et al. ("Black") were discussed. Applicant contended that Black does not teach overmold remaining "adjacent the exposed portion of the at least one arbitrarily-shaped electrode" as recited in claim 15. Applicant's argument is set forth in further detail below. The Examiner contended that Black teaches that overmold material may remain between the electrode spacers and the electrodes, which is "adjacent the exposed portion of the at least one arbitrarily-shaped electrode[.]" The Examiner's argument is set forth in further detail in the Office action. Office action, para. 2.

Applicant proposed a claim reciting that the overmold material "surrounds" the exposed portion of the arbitrarily-shaped electrode. The Examiner proposed the use of the term "encapsulates" instead of "surrounds." Applicant argued that "surround" means

¹ This summary is being prepared in advance of receiving a PTOL-413 Interview Summary. Applicant reserves the right to amend or update this summary after receipt of the Interview Summary.

"to enclose on all sides; encompass; encircle." The Examiner agreed to this definition, provided it was memorialized in writing.

Rejection Under 35 U.S.C. § 102

The Examiner rejects claims 15, 17-23, 25-27, 29, and 30 under 35 U.S.C. § 102(b) as anticipated by Black. To be anticipatory, a single prior art reference must explicitly or inherently teach each and every element of the claimed invention. MPEP § 2131 (citing Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987)). Applicant respectfully submits that Black fails to meet this standard.

Claim 15 recites "at least one arbitrarily-shaped electrode overmolded by a portion of the catheter, at least a portion of the at least one arbitrarily-shaped electrode being exposed through the overmold of the catheter and a portion of the overmold of the catheter remaining adjacent the exposed portion of the at least one arbitrarily-shaped electrode[.]" This is illustrated, for example, in Fig. 19.

Black teaches overmolding an assembly in which electrodes 18 and electrode spacers 28 are arranged on a stylet guide 24. Prior to overmolding the assembly, gaps may exist between electrodes 18 and stylet guide 24. During the overmolding process, "electrode spacers 28 and terminal spacers 30 are placed in a state of flow, which, at least in part, results in a filling of regions between terminals 16/electrodes 18 and stylet guide 24." Black, col. 7:13-16. That is, Black teaches that spacer material fills any gaps between electrodes 18 and stylet guide 24.

Black teaches grinding the overmolded assembly to remove "excessive material, including over-molded material, electrode material, terminal material, and the like[.]" *Id.*, col. 7:25-30. This grinding process results in an isodiametric lead. *Id.*; see also Figs. 1 and 2. Because Black's electrodes are recessed relative to the spacers (*Id.*, Fig. 5), all overmold material is necessarily removed in order to expose the electrodes. Thus, in Black's isodiametric lead, no overmold material remains "adjacent the exposed portion of the at least one arbitrarily shaped electrode."

The Examiner contends that gaps between electrodes 18 and stylet guide 24 are filled with overmold material. Office action, para. 5 ("The overmolding is done using an

injection molding process that results in overmold material being forced into the area between the electrodes 18 and the inner stylet guide 24.") (internal citations omitted). As set forth above, Applicant respectfully disagrees with the Examiner's reading of Black. Moreover, even assuming *arguendo* that the gaps between electrodes 18 and stylet guide 24 are filled with overmold material rather than spacer material, Applicant respectfully submits that this material is not "adjacent the exposed portion of the at least one arbitrarily-shaped electrode" as recited in claim 15. To the contrary, overmold material filling a gap between an electrode 18 and the stylet guide 24 would be adjacent the unexposed interior surface of the electrode, not the exposed exterior surface of the electrode as in the present invention.

The Examiner further contends that overmold material "is forced into any gaps or voids between insulative material (i.e., electrode spacer 28) and conductive material (i.e., electrode 18). Therefore, when the overmolded assembly is grinded...the overmold material will still be present...in any gaps between the electrode spacer and the electrodes that were filled." *Id.* (internal citations omitted). Applicant respectfully submits that Black does not teach or suggest the existence of gaps between electrodes 18 and spacers 28. The only gaps disclosed in Black are those between electrodes 18 and stylet guide 24. Moreover, even assuming *arguendo* that gaps do exist between electrodes 18 and spacers 28, Applicant respectfully submits that they are filled with spacer material rather than overmold material. *Cf.* Black, col. 7:13-16.

Thus, Applicant submits that Black fails to teach each and every element of, and therefore cannot anticipate, claim 15. Claims 17, 19-23, 25-27, 29, and 30 depend, directly or indirectly, from claim 15, and are allowable for at least the same reasons. Applicant therefore respectfully requests reconsideration and withdrawal of the rejection under section 102(b).

Rejections Under 35 U.S.C. § 103

The Examiner rejects claims 16 and 28 under 35 U.S.C. § 103 as obvious over Black. The Examiner also rejects claim 24 under 35 U.S.C. § 103 as obvious over Black in view of United States patent no. 5,125,913 to Quackenbush ("Quackenbush"). Applicant respectfully disagrees.

Though the prior art references need not teach or suggest each and every limitation of a claim for that claim to be obvious, Applicant contends that the differences between the rejected claims and the references cited are sufficiently great so as to render the claimed invention non-obvious to one of ordinary skill in the art at the time the invention was made. Examination Guidelines for Determining Obviousness Under 35 U.S.C. § 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*, 72 Fed. Reg. 57526, 57527-28 (Oct. 10, 2007) ("[T]he focus when making a determination of obviousness should be on what a person of ordinary skill in the pertinent art would have known at the time of the invention, and *on what such a person would have reasonably expected to have been able to do in view of that knowledge.*") (emphasis added). In particular, Applicant contends that the cited references do not teach "a portion of the overmold of the catheter remaining adjacent the exposed portion of the at least one arbitrarily-shaped electrode[.]" and thus one of ordinary skill in the art would not have learned the claimed invention from the asserted references.

Claims 16, 28, and 24 depend from claim 15. The shortcomings of Black with respect to claim 15 have been discussed at length above. These shortcomings are not addressed through the addition of Quackenbush. Accordingly, Applicant submits that the claimed invention is substantially different from, and therefore non-obvious over, the asserted references. Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 103.

Remarks Concerning New Claim 33

Claim 33 recites "at least a portion of the at least one arbitrarily-shaped electrode being exposed through and surrounded by the overmold of the catheter[.]" As discussed during the Interview, Applicant defines "surrounded" as confined on all sides

or encircled. Thus, claim 33 recites that the entire perimeter of the arbitrarily-shaped electrode is defined by overmold material. This is illustrated, for example, in Fig. 19.

Applicant submits that Black teaches electrodes with perimeters that are at least partially defined by electrode spacer material rather than overmold material. Accordingly, Black does not teach "at least a portion of the at least one arbitrarily-shaped electrode being exposed through and surrounded by the overmold of the catheter[.]" Claim 33 is allowable for at least this reason.

CONCLUSION

In view of the foregoing remarks, Applicant respectfully submits that the application is in condition for allowance, and requests that all rejections be withdrawn, that all pending claims be allowed, and that the application be passed to issue. If, for any reason, the Examiner finds the application to be in other than condition for allowance, the Examiner is invited to contact the undersigned in an effort to resolve any matter still outstanding before issuing another action.

No extension of time is believed necessary for this paper to be considered timely. Should an extension of time be deemed necessary, Applicant hereby petitions therefor under 37 C.F.R. § 1.136.

No fee is believed due for the addition of one independent claim herein. Authorization is hereby granted to charge any fees due with the filing of this document, including additional claim fees and fees for any extensions of time deemed necessary, to Deposit Account No. 50-1129 with reference to Attorney Docket No. 0B-045000US/82410-0067.

Respectfully submitted,

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